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09/762,532	02/08/2001	Richard Oliver		5064

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EXAMINER	
HALPERN, MARK	
ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 02/07/2003

1/
Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,532

Applicant(s)

OLIVER, RICHARD

Examiner

Mark Halpern

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39 is/are allowed.
- 6) ☒ Claim(s) 19-38, 40-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

- 1) Acknowledgement is made of Amendment received 11/22/2002, Paper No. 10. Applicant amends claims 19, 20, 24-28, 32, 38 and 40-43.

Specification

- 2) The amendment filed 11/22/2002, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: amended Specification, on pgs. 5 and 13, which recites a "pre-formed" fibriform element, is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 3) Claims 19-38, 40-43, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 19-20, 24-28, 32, 38, 40-43, have been amended to recite a "pre-formed" fibriform element. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 19-27, 29-38, 40-43, are rejected under 35 U.S.C. 103(a) as being unpatentable over Haws.

Claims 19-23, 26-27, 29-35, 38, 40-42: Haws discloses a method for applying liquid strands containing additives to cigarette rods resulting in a cigarette product wherein the tobacco rod is surrounding the liquid strand (Abstract) extending down the length of the cigarette (col. 2, lines 15-24). In the process tobacco is blown from a chimney 10 onto an advancing perforated vacuum belt 12 causing tobacco to accumulate on the belt. A liquid strand is placed near the tobacco rod accumulating area and pumped from storage 50 through pipe 51 and out through nozzle 58. In addition the materials added to the tobacco may be extruded and may be in semi-solid or solid form (col. 7, lines 18-25). This reads on the amended claims of having a pre-formed fibriform, since an extruded semi-solid or solid form is a pre-formed fibriform. It would have been obvious, to one skilled in the art at the time the invention was made,

that the pipe 51 is a guide that constrains the strand to the desired path. The air under suction causes the liquid extrudate and become impinged upon the tobacco for a certain distance along deposition run. It would have been obvious, to one skilled in the art at the time the invention was made, that the air suction flow would cause the strand to ascend toward the vacuum belt. As more tobacco is added it completely surrounds the liquid strand (col. 3, line 25 to col. 5, line 51, and Figures 1, 2, 6) into a final cigarette rod product. A variety of materials may be in the strand including flavorants and burn modifiers (col. 2, lines 36-45, and col. 6, line 45 to col. 7, line 25). The specific constraining distance is an obvious matter of apparatus design choice selected to produce the desired characteristics in the desired final product.

Claims 24, 36, 43: the strand is under the suction effect of the vacuum, however, it would have been obvious that the angle of ascent of the strand would be minimal, not more than 5 degrees. It would have been obvious, to one skilled in the art at the time the invention was made, that the degree of suction be adjusted as more tobacco material is added.

Claims 25, 37: the flow of the strand can be adjusted to any speed by the control of the pump (col. 6, lines 17-45).

Allowable Subject Matter

5) Claim 39 is allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indicating allowable subject matter is that the cited prior art does not show a method of incorporating a fibroform smoke-modifying material in a smoking material rod, wherein the fibriform is fed as a sequence of discrete fibriform elements (claim 39).

Response to Amendment

- 6) Claims 19-23, 25-27, 32-35, 37-38, 40-42, rejection under 35 U.S.C. 102(b) as being anticipated by Haws (EP 0 405 929 A2), is withdrawn in view of amended claims.
- 7) Claim 28, objection and indication of allowable subject matter, is withdrawn in view of amended claim.
- 8) Applicant's arguments filed 11/22/2002, have been fully considered but they are not persuasive.

Applicant alleges that the present Specification recites on pg. 7, line 10, that the fibriform may be a continuous element, or on pg. 7, line 13, a sequence of discrete elements. Applicant alleges the present fibriform is a pre-formed material having a degree of rigidity because it may be a continuous element, or a sequence of discrete elements.

Examiner could not locate the above recitations in the cited locations of the Specification. The reference to fibriform being a continuous element, is located in the present Specification on pg. 13, and the reference to a fibriform being a sequence of discrete elements is located in the Specification on pg. 5. In addition to the cited reference indication that the fibriform is a liquid, the reference discloses that materials to

be added to the tobacco may be extruded and may be in semi-solid or solid form (col. 7, lines 18-25). This reads on the amended claims of having a pre-formed fibriform, since an extruded semi-solid or solid form is a pre-formed fibriform. Such an extrudate has a degree of rigidity.

Applicant alleges that the amending of Specification and claims to recite "pre-formed" in connection with the fibriform element does not constitute new matter.

Examiner responds that the recitation of "pre-formed" in connection with the fibriform element does constitute new matter because it provides a new limitation of what a fibriform element is. In the original filing a fibriform could be a "pre-formed" fibriform or one generated in the apparatus. A "pre-formed" limitation did not exist in the original filing.

Applicant alleges that claim 38 was allowed.

The examiner responds to indicate that the allowed claim is claim 39.

Applicant alleges that the material feeding to the rod-making machine is not in a longitudinal direction of the travel of the suction band of the machine, as shown in Figures 1, 2, and 4 of Haws, since the pipe feeding the liquid strand is perpendicular to the path of the travel.

The examiner responds as follows. The pipe configuration is both, perpendicular or horizontal to the travel path, however the pipe configuration is of no importance. As shown in Figure 2 of Haws, the nozzle 58, emitting the liquid strand material is oriented longitudinally in the direction of travel of the suction band of the machine.

Applicant alleges that the Haws reference does not disclose a guide for feeding the fibriform material into the rod-making machine.

The examiner responds as follows. As shown in Figure 2 of Haws, the piping 51 is a strand guide for feeding the material into the rod-making machine.

Applicant alleges that the meaning of the term fibriform is further supported by the applicant provided citations from two dictionaries.

Examiner responds that the fibriform as per item 4 above is in conformance with description provided in the instant Specification and claims.

Conclusion

9) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

MH

Mark Halpern
Patent Examiner
Art Unit 1731

February 5, 2003


JAMES DERRINGTON
PRIMARY EXAMINER
ART UNIT ~~137~~ 1731